

Inventor(s): J. T. Lin
Appln. No.: 0 / _____ or Patent No. _____
Filed: May 27, 1998 or Issued: _____
Title: OPHTHALMIC SURGERY METHOD USING NON-CONTACT
SCANNING LASER

(Atty. Dkt. 62-575)

VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY
STATUS (37 CFR 1.9(d) and 1.27(c)) - **SMALL BUSINESS CONCERN**

I hereby declare that I am

- ☐ the owner of the small business concern identified below:
☒ an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF CONCERN LaserSight, Incorporated
ADDRESS OF CONCERN 12249 Science Drive, Suite 160
Orlando, Florida 32826

I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.12, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees under Section 41(a) and (b) of Title 35, United States Code, in that the number of employees of the concern, including those of its affiliates, does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has the power to control the other, or a third party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention **entitled:** OPHTHALMIC SURGERY METHOD USING NON-CONTACT
SCANNING LASER

by **inventors(s)** J. T. Lin described in

X ☒ the Specification filed herewith,
one ☐ Application No. 0 / _____, filed _____
box ☒ Patent No. 5,520,679, issued May 28, 1996

I acknowledge the duty to file, in this case, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small entity is no longer appropriate. (37 CFR 1.28(b))

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING William I. Kern

TITLE OF PERSON OTHER THAN OWNER Vice President of Corporate Development

ADDRESS OF PERSON SIGNING 159 Durham Place, Longwood, Florida 32779

SIGNATURE  DATE 5/21/98

**DECLARATION AND POWER OF ATTORNEY FOR REISSUE APPLICATION
BY ASSIGNEE AND INVENTOR**

We, Dr. J. T. Lin and William I. Kern in support of the reissue declaration of inventor and assignee, declare and state as follows:

1. We believe that Dr. J. T. Lin is the original, first and sole inventor of the invention entitled OPTHALMIC SURGERY METHOD USING NON-CONTACT SCANNING LASER described and claimed in Letters Patent No. 5,520,679 issued on May 28, 1996 from original Application No. 08/218,319 filed March 25, 1994, which is a Continuation-in-Part of Application No. 07/985,617, filed December 3, 1992, and described and claimed in the foregoing attached reissue application. We do not believe that this invention was known or used in the United States before Dr. J. T. Lin's invention thereof, or patented or described in any publication in any country before his invention thereof or more than one year prior to the original application dates of December 3, 1992 or March 25, 1994, or in public use or on sale in the United States more than one year prior to the original application dates of December 3, 1992 or March 25, 1994. This invention has not been patented in any country foreign to the United States prior to the date of the original application on an application filed by Dr. J. T. Lin or his legal representatives or assigns more than 12 months before his original application. We have reviewed and understand the contents of specification and claims as amended by the attached reissue application.

2. Dr. J. T. Lin's residence, post office address and citizenship are as stated below next to his signature.

6. We now understand and believe that certain language is unnecessarily limiting and its inclusion in the claims of U.S. Patent No. 5,520,679 is an error introduced by prior counsel, who apparently failed to appreciate the significance of the invention. Thus, we believe the original U.S. Patent No. 5,520,679 contains an error that occurred without deceptive intent that renders the patent partly inoperative as a legal document by reason of the patentee claiming less than he had a right to claim.

In a first Official Action, dated April 4, 1995, the Examiner rejected claims 1-25 for informal reasons, claims 1, 12-19, 24 and 25 as allegedly being anticipated by U.S. Patent No. 4,729,372 (L'Esperance) under 35 U.S.C. § 102(b) and claims 3-13 and 20-23 as allegedly being obvious over L'Esperance under 35 U.S.C. § 103. In particular,

the Examiner alleged that L'Esperance "discloses a method and apparatus for performing laser surgery on the eye as claimed, including the steps of coupling the laser to a scanning device 14 to deliver a scanned beam to the corneal surface." The Examiner admitted that L'Esperance does not disclose "the particular parameters recited" in the claims, but alleged that to provide L'Esperance "with the particular irradiation ranges and parameters recited would have been obvious to an artisan of ordinary skill in the art for facilitating the corrective therapeutic outcomes."

An Amendment responsive to the first Official Action was filed on August 4, 1995. Claims 1, 2, 5-12, 14-19 and 25 were amended to address informalities. Claim 1 was also amended to recite the removal of from .05 to .5 microns of corneal tissue per pulse. The Applicant argued that L'Esperance did not teach using an irradiation energy level of 10 mJ/pulse or less or removal of from 0.5 to .5 microns of corneal tissue per pulse as recited. The Applicant pointed out that L'Esperance proliferated the use of conventional high power laser beam equipment by teaching the removal of 14 microns of tissue per pulse, i.e., 42 times the maximum amount recited in claim 1 of the application.

In a second Official Action dated November 21, 1995, the Examiner rejected claims 1 and 5-25 under 35 U.S.C. § 103 as allegedly being obvious over L'Esperance. Claims 2-4 were deemed to include informal errors but nevertheless to recite allowable subject matter. The Examiner correctly understood that the invention was "directed towards reducing the size and power of the laser for performing this surgery." The Examiner admitted that L'Esperance disclosed laser power far outside of the claimed range, i.e., having a maximum power of 200 mJ/pulse in a disclosed embodiment which removes 14 microns of tissue per pulse.

An Amendment responsive to the second Official Action was filed on December 22, 1995. Claim 1 was amended to incorporate the subject matter of allowable claim 2, claims 3 and 4 were amended to be dependent upon claim 1, and claim 25 was canceled. The Amendment was entered and the Examiner issued a Notice of

How the Error Was Discovered

The Error Was Made Without Deceptive Intent

How the Error is Corrected

For instance, in the Notice of Allowability dated January 31, 1996, the Examiner stated the following reasons for allowance:

"... the claims now set forth a specific method for performing corneal refractive surgery which includes the steps of selecting a particular laser source and scanning mechanism, and controlling the scanning mechanism to remove a specific amount of corneal tissue through the use of a low power laser. The prior art fails to anticipate or fairly suggest the method steps as set forth in the claims."

New claim 48 at page 6, line 11, page 14, lines 8-10, page 15, line 22 through page 16, line 7, page 23, lines 21-29, and Figs. 6A-6D;

New claim 75 at page 6, line 13;

New claim 80 at page 15, lines 22-33;

New claims 81 and 87 at page 14, lines 8-10;

New claims 82, 83 and 98 at page 13, lines 5-9, and 15, line 7;

New claim 85 at page 6, line 21;

New claim 86 at page 4, line 28;

New claims 91 and 99 at page 6, line 18 to page 7, line 12;

New claims 102 and 103 at page 18, lines 10-11; and

New claim 104 at page 19, line 22.

New claims 36, 45, 64, 78 and 94 at page 15, line 7, page 27, line 26 in combination with page 29, line 16;

New claim 77 at page 32, line 5; and
New claims 100 and 101 at pages 9 and 10.

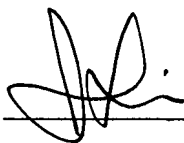
Support for new claim 90 can be found at patent claim 1.

**William H. Bollman
Farkas & Manelli, PLLC
2000 M Street, N.W., 7th Floor
Washington, D.C. 20036-3307
Tel: (202) 261-1000
Fax: (202) 861-0336**

Re-issue Declaration
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15. We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this reissue application or any patent issued thereon.

Inventor's Signature: _____



Date: _____

May 21, 1998

Inventor's Name: _____

J.

T.

Lin

U.S.A.

First

Middle Initial

Family Name

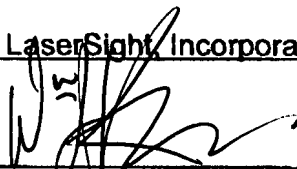
Country of Citizenship

Residence (City): Winter Springs(State/Foreign Country) FloridaPost Office Address (Include Zip Code): 730 Willow Run lane, Winter Springs,Florida 32792

Assignee: _____

LaserSight, Incorporated

Signature: _____



Date: _____

5/21/98

By: _____

William

I.

Kern

U.S.A.

First

Middle Initial

Family Name

Country of Citizenship

Assignee's Title: Vice President of Corporate Development, LaserSight, IncorporatedResidence (City): Longwood(State/Foreign Country) FloridaPost Office Address (Include Zip Code): 159 Durham PlaceLongwood, Florida 32779

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